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10/031,138	05/02/2002	Miyawaki Hiroshi	967 022	8211
20874 7590 05/28/2008 MARIAMA MULDOON BLASIAK & SULLIVAN LLP 250 SOUTH CLINTON STREET SUITE 300 SYRACUSE, NY 13202				
EXAMINER				
FERTIG, BRIAN E				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/031,138

Applicant(s)

HIROSHI, MIYAWAKI

Examiner

BRIAN FERTIG

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to Applicant's filing of 3/3/2008. Independent claims 1 and 2 have been amended and claims 1-22 are pending and examined below.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 3 and 13

The phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

With respect to claims 1-3 and 13

These claims attempt to define systems components in relation whether they are "on the terminal server side" or "in the information terminal". It is not clear from the claim language, however, whether this limitation is meant to carry down to structures not immediately following this limitation (i.e. to structures such as the charging database, customer database, usage and data monitor or a usage state monitor). For the purposes of examination, it is assumed that these limitations only apply to the limitations immediately following the limitation (i.e. not to that charging database, etc). Examiner

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suggests either adding a colon with additional indents to better identify the included structures or wrote copying of the limitation to all structures the bear the limitation.

With respect to claims 3-22

These claims are rejected for incorporating subject matter rejected above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,240,091 to Ginzboorg (Ginzboorg).

With respect to claim 1

Ginzboorg teaches:

An Internet charging system in a system having an information terminal and a terminal server that provides Internet access service employing a public network to the information terminal, comprising:

on the terminal server side (i.e. on system components that are not the information terminal),

a charging server for sequentially calculating an Internet usage fee which occurs according to Internet usage by an Internet user through the information terminal (i.e. charging system in

combination with billing system, see col 5, line 47-col 6, line 10, note that the charging server collects the charging records which are generated at specific intervals, suggesting that billing is accomplished based on a sequence of charging records. Note further that the charging records are generated to reflect the user's Internet usage);

a charging database having a charging table required for calculating the Internet usage fee (i.e. service list, including price list, see col 7, lines 35-50, note that a price list is required to calculate the usage fee since it defines the rate at which the fee will be charged in combination with charging records, see col 5, line 47-col 6, line 10, col 14, line 36-col 15, line 36 and Fig 8 which determine the amount of use the user has accrued); and

a customer database having a customer table which includes information on a customer as the Internet user through the information terminal (i.e. collected charging records, see col 5, line 47-col 6, line 10, col 14, line 36-col 15, line 36 and Fig 8, note that charging records contain fields for Identifiers which contains information about the customer. Since this information is in the context of a charging record that documents internet usage, this information is also information on the customer as an internet user. Alternatively, subscriber database, see col 9, lines 1-3),

wherein, on the terminal server side, the charging table which includes information on an Internet access method (see col 7, lines 11-50, note that the services/price list contains information on the type of connection that the user may select. This is an internet access method in so far as it allows the consumer to select which type of connection will be used to provide the terminal with internet access), a method for displaying information for charging (i.e. a transmittable services/price list, see col 7, lines 39-50, note that the list is transmitted from the terminal server side), and a charging method associated with Internet access is periodically transmitted to the information terminal (i.e. a price associated with the service/connection type, note that the list is transmitted to the terminal immediately after the smart card is inserted), wherein the information terminal is adapted to allow the customer to select a desired charging method information from the information in the transmitted charging table (see col 7, lines 11-50 and fig 4, note that the terminal displays a selection window from which the user can select a service and associated price that was updated from the terminal server side).

Ginzboorg does not explicitly teach databases and tables, however, they are suggested by the fields and relationships that must be maintained between the data elements. It would have been obvious to one having ordinary skill in the art at the time of applicant's

invention to have provided Ginzboorg with databases and tables since such a data structure accommodates the charging records which contain fields of information whose inter-relationship must be maintained in order for the data to have meaning and also accommodates relating each service in the services list to a charging rate in order to accurately charge a user based on the connection type selected for internet access.

5. Claim 2-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg in view of US Patent 5,913,040 to Rakavy (Rakavy)

With respect to claim 2

Ginzboorg teaches:

An Internet charging system in a system having an information terminal and a terminal server that provides Internet access service employing a public network to the information terminal, comprising:

on the terminal server side (i.e. on system components that are not the information terminal),

a charging server for sequentially calculating an Internet usage fee which occurs according to Internet usage by an Internet user through the information terminal (i.e. charging system in combination with billing system, see col 5, line 47-col 6, line 10, note that the charging server collects the charging records which are generated at specific intervals, suggesting that billing is accomplished based on a sequence of charging

records. Note further that the charging records are generated to reflect the user's Internet usage);

a charging database having a charging table required for calculating the Internet usage fee (i.e. service list, including price list, see col 7, lines 35-50, note that a price list is required to calculate the usage fee since it defines the rate at which the fee will be charged in combination with charging records, see col 5, line 47-col 6, line 10, col 14, line 36-col 15, line 36 and Fig 8, which determine the amount of use the user has accrued);

a customer database having a customer table which includes information on a customer as the Internet user through the information terminal (i.e. collected charging records, see col 5, line 47-col 6, line 10, col 14, line 36-col 15, line 36 and Fig 8, note that charging records contain fields for Identifiers which contains information about the customer. Since this information is in the context of a charging record that documents internet usage, this information is also information on the customer as an internet user. Alternatively, subscriber database, see col 9, lines 1-3);

wherein on the terminal server side, the charging table which includes information on an Internet access method (see col 7, lines 11-50, note that the services/price list contains information on the type of connection that the user may select. This is an internet access method in so far as it allows the consumer to select which type of connection will be

used to provide the terminal with internet access), a method for displaying information for the charging (i.e. a transmittable services/price list, see col 7, lines 39-50, note that the list is transmitted from the terminal server side), and a charging method associated with Internet access is periodically transmitted to the information terminal (i.e. a price associated with the service/connection type, see col 7, lines 39-50, note that the list is transmitted to the terminal immediately after the smart card is inserted),

a usage state monitor server for monitoring a state of Internet usage by the customer (i.e. router, see col 10, line 31-col 11, line 5, note that the router monitors the state of the internet usage by the customer in its application of the access lists controlled by the access server),

a data traffic monitor server for monitoring data traffic of the Internet (i.e. router, see col 10, line 31-col 11, line 5, note that the router monitors the data traffic related to the internet usage by the customer in its application of the access lists controlled by the access server)

on the information terminal side, the customer selects desired information from the information in the transmitted charging table (see col 7, lines 11-50 and fig 4, note that the terminal displays a selection window from which the user can select a service and associated price that was updated from the terminal server side), and on the terminal server side, an Internet access service providing method (i.e. opening the internet connection by controlling the router/concentrator, see col 6, lines 10-16),

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and the charging method associated with Internet access are changed according to the state of Internet usage by the customer and the result of the selection by the customer of the desired charging method information in the charging table (see col 11, lines 15-22 and col 12, lines 1-29, note that users are charged based on charging records which correspond to the state of internet usage of the customer. Note further that the rate customers are charged are based upon the services/connection the user selects.).

Ginzboorg does not explicitly teach:

an advertisement content server for retaining contents of the advertisement;

an advertisement data controller for controlling a size and a display time of an advertisement which is sent to the terminal server;

on the terminal server side, an advertisement distribution method

Rakavy teaches:

an advertisement content server for retaining contents of the advertisement (i.e. Advertising system server, see col 5, lines 32-35);

an advertisement data controller for controlling a size and a display time of an advertisement which is sent to the terminal server (see col 7, lines 13-30, note that the Server database contains Advertisement Information Records which contain client requirements for displaying the advertisements and related size and col 5, lines 33-52 teaching that the

Advertising server selects which advertisement to send. The combination of these teachings suggest that the Advertising server is capable of controlling the size and display time of the advertisement. Note further that the advertisement has been sent to the terminal server since it has been stored on the Advertising system server, which is distinct from the information terminal);

on the terminal server side, an advertisement distribution method (i.e. Advertisement System Server transfers advertisements to the local computer, see col 5, lines 31-35)

It would have been obvious to one having ordinary skill at the time of Applicant's invention to have provided Ginzboorg with the advertising distribution features of Rakavy in order to display advertisements on a local computer from a remote network in the context of a commercial, on-line service as taught explicitly by Rakavy (see col 1, lines 15-18)

With respect to claims 3 and 13

Ginzboorg in view of Rakavy teaches:

comprising:

in the information terminal,

an access program for accessing the Internet (i.e. WWW browser, see Ginzboorg, col 11, line 25-26);

a usage state monitor program for monitoring the state of Internet usage by the customer (i.e. Polite Agent, see col 7, lines 58-61);

an information terminal charging database having an information terminal charging table which includes information required for calculating the Internet usage fee (i.e. downloaded services/price list, see Ginzboorg, col 7, lines 35-50); and

an access setting database having an access table which includes information on plural providers such as phone numbers, ID numbers, passwords, wherein the information terminal is configured to automatically change a provider (see Rakavy, col 5, lines 54-65, note that multiple advertisement servers are contemplated and the Local Computer is sent the addresses of the appropriate servers to contact. Note that the changing between advertisement servers is done without user intervention, see also Ginzboorg, col 6, lines 61-67 ad Fig 3c and 3d).

(See rationale supporting obviousness and motivation to combine of claim 2 above)

With respect to claims 4 and 14

Ginzboorg in view of Rakavy teaches:

wherein the charging table has line usage fee information concerning a usage fee of the public network (i.e. latest prices, see Ginzboorg, col 7, line 45).

(See rationale supporting obviousness and motivation to combine of claim 2 above)

With respect to claims 5 and 15

Ginzboorg in view of Rakavy teaches:

wherein the charging table has advertisement size information concerning a size of the advertisement displayed on the information terminal (see Rakavy col 7,

lines 13-29, note that the Server Data base contains Advertising Information records containing advertisement size).

It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to have stored the advertisement size information in the charging table of Ginzboorg in order to have consolidated the system data into a single table that could be transmitted to the user so as to inform the user of current the services and price information available via the system as taught explicitly by Ginzboorg (see col 7, lines 35-50, See also rationale supporting obviousness and motivation to combine of claim 2 above)

With respect to claims 6 and 16

Ginzboorg in view of Rakavy teaches:

wherein the charging system has advertisement number information concerning the number of advertisements displayed on the information terminal (see Rakavy, see col 5, lines 31-41, note that the System Server tracks which Advertisements have been downloaded to the user).

It would have been obvious to one having ordinary skill in the art a the time of applicant's invention to have provided the charging system of Ginzboorg with the tracking information of Rakavy in order to have allowed the system to generate charging records related to the access sessions of the user as taught explicitly by Ginzboorg (see sol 8, lines 22-30, See also rationale supporting obviousness and motivation to combine of claim 2 above)

With respect to claims 7 and 17

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Ginzboorg in view of Rakavy teaches:

wherein the charging table has advertisement display time information concerning a display time of the advertisement displayed on the information terminal (see Rakavy col 7, lines 43-61, note that the Feedback manager sends back user statistics which fairly suggests advertisement display time).

(see rationale supporting obviousness and motivation to combine of claims 2, 6, and 16 above)

With respect to claim 8 and 18

Ginzboorg in view of Rakavy teaches:

wherein the charging table has usage time-zone information concerning a time zone in which the client uses the Internet (see col 5, line 47-col 6, line 10, col 14, line 36-col 15, line 36 and Fig 8, note the time stamp information, in combination with col 13, lines 45-54, teaching the problems related to time based charging. Note that the combination of these teaching fairly suggests that accuracy and synchronization required between use and charging elements of the system, thus including time zone information as a means to insure synchronization would have been obvious).

(see rationale supporting obviousness and motivation to combine of claims 2, 6, and 16 above)

With respect to claims 9 and 19

Ginzboorg in view of Rakavy teaches:

wherein the charging table has information on accumulated access time that is an accumulation of time for which the customer uses the Internet (see Ginzboorg col 11, lines 15-22 and col 12, lines 1-29, note that users are charged based on charging records which correspond to the state of internet usage of the customer. Note further that the rate customers are charged are based upon the services/connection the user selects.).

(see rational supporting obviousness and motivation to combine of claim 2 above)

With respect to claim 10 and 20

Ginzboorg in view of Rakavy teaches:

wherein the charging table has data packet amount information concerning an amount of data packets utilized in the Internet (see Ginzboorg col 5, line 47-col 6, line 10, col 14, line 36-col 15, line 36 and Fig 8, note that the charging records contain a field for LENGTH and TRAFFIC DATA).

(see rational supporting obviousness and motivation to combine of claim 2 above)

With respect to claims 11 and 21

Ginzboorg in view of Rakavy teaches:

wherein the charging table has communication traffic state information concerning a communication traffic state in the public network (see Ginzboorg col 10, lines 43-67, note that the charging server sends an OK message in order to allow user to gain access to the internet, as such the sending of the OK message suggests that the charging table has traffic state information concerning the user's access to the public network).

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(see rational supporting obviousness and motivation to combine of claim 2 above)

With respect to claims 12 and 22

Ginzboorg in view of Rakavy teaches:

wherein the charging table has electric commerce deal amount/frequency information, which concerns a deal amount when the customer performs electronic commerce employing the Internet, and a frequency of performing the electronic commerce (see Ginzboorg col 5, line 47-col 6, line 10, col 14, line 36-col 15, line 36 and Fig 8, note that the charging records contain fields for SERVICE IDENTIFIER, STARTING TIME, ENDING TIME, TRAFFIC DATA. These fields contain information about the frequency and content of all of a users interaction with the Internet, including any electronic commerce transactions they may perform).

(see rational supporting obviousness and motivation to combine of claim 2 above)

Response to Arguments

6. Applicant's arguments filed 3/3/2008 have been fully considered but they are not persuasive. In response to Applicant's argument that Ginzboorg at least fails to teach or even suggest the user's selecting a charging method information from a charging table, Examiner respectfully disagrees. Ginzboorg (see col 7, lines 15-50) teaches a selection window, pictured in Fig 4 from which a user can select the type of connection required. These connections are a charging method in so far as their selection is related to a different fee rate (see col 7, lines 26-29 and 39-50). Further, the selections and

associated prices are from a charging table in so far as they are retrieved from either the charging or billing servers when the window is presented to the user (see col 7, lines 39-50). Note that a data base of prices is implied by the relationship that exists and must be maintained between connection and its price. Such a relationship must be maintained in order for the user to be billed for the selected connection at the appropriate rate.

7. In response to Applicant's argument that Rakavy at least fails to teach or even suggest sending a charging method information to the user's terminal, and the user's selecting a charging method information from a charging table, Examiner respectfully cites Ginzboorg's teaching of a selection window presented to the user as described above (see Ginzboorg, col 7, lines 15-50 and fig 4)

8. In response to Applicant's argument that Monachello at least fails to teach or even suggest sending a charging method information to the user's terminal, and the user's selecting a charging method information from a charging table, Examiner respectfully cites Ginzboorg's teaching of a selection window presented to the user as described above (see Ginzboorg, col 7, lines 15-50 and fig 4).
9. In response to Applicant's argument that dependent claims 3-22 are allowable based on their dependence from independent claims 1 or 2, Examiner respectfully disagrees in light of the discussion above.

Allowable Subject Matter

10. While no allowable subject matter is recited as set forth in the claims above, Examiner notes that Applicant has chosen to claim the invention in terms of a system (i.e. machine or manufacture). Generally, a machine or manufacture must contain a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Further, descriptive material (i.e. data elements recited which, as claimed, do not impart any functionality to the system) are considered, but may not be given patentable weight.
11. Examiner notes that Applicant has claimed structural difference in terms of defining limitations in terms of "on the terminal server side" or "in the information terminal", however, many of the features of Applicant's invention appear to be accomplished through software and data processing, which often do not often involve distinguishing structural differences. These features may better be captured in

distinguishable form when expressed as steps. As such, Examiner respectfully suggests that Applicant consider the process statutory category in drafting the claims, to the extent Applicant's disclosure supports such drafting.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/B.F./

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694